

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed September 23, 2008. At the time of the Final Office Action, Claims 1-15 were pending in this Application. Claims 1-15 were rejected. Claim 1 has been amended. Claims 6 and 7 were previously cancelled without prejudice or disclaimer and Claims 16-21 were previously withdrawn due to an election/restriction requirement. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-2, 4-5 and 8-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over German Patent No. 19715487 by Johannes Fitzner et al. ("*Fitzner*") and further in view of International Application Publication No. WO2004/004021 by Markus Mohr ("*Mohr*").

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Fitzner* in view of *Mohr* and in view of U.S. Patent No. 4,778,358 issued to Werner Pape ("*Pape*").

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog*

Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Claim 1 has been amended to correct a minor formal detail. The wording “holder” in the last line of claim 1 has been amended to read “the holder”.

The rejection under 35 U.S.C. §103(a) is respectfully traversed because *Mohr* does not teach or disclose that a first and second rib couple a top and bottom plate to form a holder. Neither does *Fitzner* as conceded by the Examiner. Office action, page 3. Therefore one of ordinary skill in the art would not be able arrive at the subject matter of claim 1 when considering *Mohr* and *Fitzner*.

Figure 1 in the Office Action corresponds to Figure 3 in *Mohr*. This Figure 3 illustrates the prior art discussed on page 1 in *Mohr*. Here it is explained that the piezo stack 1 is provided with insulating foils 6. *Mohr*, page 1, lines 16-18. The top housing part 8 and the bottom housing part 9 forms the holder in which the piezo stack 1 (and also wires 2 and 3, pins 4 and 5, stack 1, and insulation foils 6) is inserted. *Mohr*, page 1, lines 18-22. (Hereafter a silicon material is used to cast the device.) As may be taken best from the Figure 3, the top housing part 8 and the bottom housing part 9 connect to each other by respective threaded portions. In other words, the insulation foils 6 do not couple the top housing part 8 and the bottom housing part 9 to form a housing. The insulation foils 6 are attached to the piezo stack 1 and not to the top housing part 8 or the bottom housing part 9. The insulation foils are not technically equivalent to the claimed first and second ribs, because insulation foils for piezo actuators are very thin and can not form a holder together with the top housing part 8 and the bottom housing part 9.

Since *Mohr* fails to teach or suggest that a first and second rib couple a top and bottom plate to form a holder, it is respectfully requested that the rejection under 35 U.S.C. §103(a) is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.


CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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A handwritten signature in black ink, appearing to read 'A. Grubert', with a stylized flourish at the end.

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Date: December 22, 2008

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